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EXAMINER

PREBILIC, P

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

02/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/878,908

Applicant(s)
Lauterjung

Examiner
Paul Prebilio

Group Art Unit
3738



☒ Responsive to communication(s) filed on Nov 5, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 12-17, 19-26, 28, 32, 33, and 36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 32, 33, and 36 is/are allowed.

☒ Claim(s) 12-17, 19-26, and 28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 17

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The amendments proposed for claims 18 and 27 by the November 5, 1999 amendment were not made because these same claims were canceled by the September 3, 1998 amendment.

The claims presented for examination overcame the previous grounds of rejection but the discovery of a new piece of prior art to McNamara et al has prompted this new non-final Office action. The Office regrets the delay in finding this relevant prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-17, 19-26, and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment filed August 2, 1999 amended the present claims to include a limitation that the "graft" not the annular "elements" or "springs" had a greater resiliency on one end compared to the other end. However, the Examiner could not find original support for the "graft" absent the annular "elements" or "springs" as having a greater resiliency on one end as compared to the other as presently claimed. Therefore, the Examiner posits that the claims contain new matter.

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With regard to claims 16 and 26 specifically, it is not seen how the present claims have original support from the disclosure because the annular elements disclosed are what give the prosthesis its resiliency.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-17, 19-26, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 12-17, 19-26, and 28, as an alternative to the above 35 USC 112, first paragraph rejection, the Examiner posits that the claims could be interpreted as merely indefinite in that they fail to properly claim the disclosed invention. In other words, the claims may fail to state that the resiliency of the graft (more accurately, the prosthesis) is due to the annular elements.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 12, 13, 17, 19-25, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by McNamara et al (US 6,004,347) wherein the anchor thereof is the annular spring as claimed; see the whole document.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNamara et al (US 6,004,347) in view of Parodi (US 5,578,071).

McNamara et al meets the claim language as set forth above, but fails to make one end of the graft larger than the other end as claimed. Parodi, however, teaches that it was known to make one end of the graft larger than another when the graft is used in bifurcated region of the blood vessel to be repaired; see Figure 6 and the corresponding text therefor. Hence, it is the Examiner's position that it would have been obvious to make one end of the graft larger than the other so that the graft of McNamara et al could be used to repair a bifurcated blood vessel.

Allowable Subject Matter

Claims 16 and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Claims 32, 33, and 36 are allowed over the prior art of record.

Response to Arguments

Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.

Paul Prebilic
Primary Examiner
Art Unit 3738